

### **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on January 30, 2003, and the references cited therewith.

Claim 17 is amended, claims 25-41 are withdrawn. Claims 1-24 are currently being considered in this application.

#### **Affirmation of Election**

As provisionally elected by Applicants representative, **Bradley Forrest**, on August 8, 2002, Applicant elects to prosecute the invention of Group I, claims 1-24.

The claims of the non-elected invention, claims 25-41, are hereby withdrawn from consideration. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

#### **§112 Rejection of the Claims**

Claims 17 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 17 has been amended solely to provide sufficient antecedent basis.

#### **§103 Rejection of the Claims**

Claims 1-4 and 9 were rejected under 35 USC § 103(a) as being unpatentable over Cole et al.(U.S. Patent No. 5,550,373) in view of Tokuda et al. (U.S. Patent No. 5,144,397). This rejection is respectfully traversed. A prima facie case for combining the references has not been established.

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action stated "It would have been obvious to use the Tokuda et al. detector in the Cole et al. device to improve the wavelength sensitivity." which is a mere conclusory statement of subjective belief, so Applicant respectfully submits that the Office

Action has not provided objective evidence for a suggestion or motivation to combine the references.

Cole et al. is concerned with sensing light passed from a filter. Only the “portion of the light that is passed by the cavity is detected by an infrared microbolometer or CCD array.” Abstract. Thus, there is no suggestion in Cole et al. that multiple detectors for different wavelengths would be needed, since the different wavelengths are removed by the filter. Only the wavelength passed by the filter need be detected. Some embodiments of Tokuda et al. are directed at detecting different wavelengths. There is no filter in Tokuda et al. that screens out these different wavelengths. Thus, the stated reason for combining them is actually against the teaching of the references. They clearly are directed to different purposes, and there is no actual suggestion to combine them other than by using the current application impermissibly as a roadmap.

Claims 2-4 and 9 depend from claim 1 and are believed allowable for at least the same reasons as claim 1.

Claims 5-8 and 12 were rejected under 35 USC § 103(a) as being unpatentable over Cole et al. in view of Tokuda et al. and further in view of Hier et al (U.S. Patent No. 6,407,439) and Koslowski et al. (U.S. Patent No. 6,483,116). This rejection is respectfully traversed. Claims 5-8 depend from claim 1, which as shown above is not obvious in view of the references. Hier et al. is not cited as providing elements of claim 1 and therefore a prima facie case of obviousness has not been established for claims 5-8. Further, claims 5 and 6 recite certain ratios for the elements of the detectors that are not specified in Koslowski et al. Claims 7 and 8 recite specific wavelength ranges of responsiveness that are not taught in Koslowski et al. Claim 12 depends from claim 10 and is believed allowable for at least the same reasons as claim 10 discussed below.

Claims 10,11,13-17, 19, 23 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Cole et al. in view of Tokuda et al. and Yokoi (U.S. Patent No. 6,459,484). This rejection is respectfully traversed. Independent claims 10 and 24, as well as all the other claims depending therefrom are believed allowable for at least the same reasons as claim 1.

Yokoi is not cited as providing a suggestion for the combination of Cole et al. and Tokuda. Claims 10 and 24 both recite the combination of bandpass filter and first and second detectors for detecting low and high wavelengths passed by the bandpass filter as recited in claim 1. Thus, the rejection should be withdrawn and the claims allowed. The dependent claims contain further elements not shown. In particular, it should be noted that there is no application of the references to the elements of claim 17, wherein the “first and second substrates are positioned such that the first substrate is positioned between a biosample and the second substrate.”

Claims 20-22 were rejected under 35 USC § 103(a) as being unpatentable over Cole et al. in view of Tokuda et al. and further in view of Hier et al. and Koslowski et al. This rejection is respectfully traversed. Claims 20-22 depend from claim 10, which as shown above is not obvious in view of the references.

Allowable Subject Matter

Claim 18 was indicated to be allowable if rewritten to overcome the rejection(s) under 35 USC § 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

BARRETT E. COLE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
612-373-6972

Date 4/30/2003

By Bradley A. Forrest  
Bradley A. Forrest  
Reg. No. 30,837

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 30 day of April, 2003.

Gina M. Uphus

Name

Gina Uphus

Signature